



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO. 087989,881	FILING DATE 12/12/97	FIRST NAMED INVENTOR SHEEN	ATTORNEY DOCKET NO. 082727/10112
-------------------------------	-------------------------	-------------------------------	-------------------------------------

KAREN L ELBING
CLARK & ELBING
176 FEDERAL STREET
BOSTON MA 02110

HM32/0624

EXAMINER ZAGHMOUT, D

ART UNIT 1549	PAPER NUMBER
------------------	--------------

DATE MAILED: 06/24/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/989,881

Applicant(s)

Sheen

Examiner
Ousama Zaghmout

Group Art Unit
1649



☒ Responsive to communication(s) filed on Dec 12, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-48 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-48 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1649

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 24-26, 36-46 are drawn to a method for protecting plants against stress by expressing the nucleic acid molecule encoding recombinant protein kinase (PK), and resultant transgenic plants, classified in class 800, subclass 278 for example.
 - II. Claims 8-14, 27-29 are drawn to a method for protecting plants against stress by expressing the nucleic acid molecule encoding recombinant calcium-dependent protein (CDPK), and resultant transgenic plants, classified in class 800, subclass 278 for example.
 - III. Claims 15-22 are drawn to a method for protecting plants against stress by expressing the nucleic acid molecule encoding Cam-K protein, and resultant transgenic plants, classified in class 800, subclass 278 for example.
 - IV. Claims 23, 33-35 are drawn to a method for protecting plants against stress by expressing the nucleic acid molecule encoding recombinant protein kinase (PK), CDPK and Cam-K proteins, and resultant transgenic plants, classified in class 800, subclass 278 for example.

Art Unit: 1649

V. Claims 47-48 are drawn to a PK protein, classified in class 530, subclass 300, for example.

2. The inventions are distinct, each from the other because of the following reasons:

a. Each invention is drawn to a molecularly and a biochemically divergent products and processes not required by the other.

b. Group I-IV are distinct from each other as each entails the expression of a nucleic acid molecule which encode a completely different and patentability distinct proteins. In addition, the invention of group I, does not require the presence of cDPK or Cam-K proteins of the invention of group V. The inventions of groups II and III do not require the presence of 2 or 3 proteins as in group IV.

Furthermore, the nucleotide sequences or the transgenic plants that express said nucleotide sequences are not required by the invention of group V which is drawn into a protein. Moreover, the invention of group V could be made by a process other than the expression of the genes of groups I-IV, such as chemical synthesis.

As such, the invention in each one of these groups require separate search and it be burden on the Examiner to examine more than one invention in one application.

Art Unit: 1649

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently amendment of inventorship must be accompanied by a diligently-filled petition under 37 CFR 1.148(b) and the fee required under 37 CFR 1.17(h).

Art Unit: 1649

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.
June 17, 1999


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

8

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Please see attached.

Art Unit: 1649

OFFICE ACTION

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2).

However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant is given ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Art Unit: 1649

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.

June 17, 1999


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600